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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|----------------------|------------------|
| 10/697,560 | 10/31/2003 | Thomas Grafenauer | 03100132US | 8411 |
| 7055 | 7590 | 03/10/2006 | EXAMINER | |
| GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191 | | | FERGUSON, LAWRENCE D | |
| | | ART UNIT | PAPER NUMBER | |
| | | 1774 | | |

DATE MAILED: 03/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|---|-------------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 10/697,560 | GRAFENAUER, THOMAS |
| | Examiner Lawrence D. Ferguson | Art Unit 1774 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 09 January 2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-9 and 11-15 is/are pending in the application.
- 4a) Of the above claim(s) 11-15 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-9 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 31 October 2003 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 9/21/05;10/31/03.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

Response to Election

1. This action is in response to the provisional election mailed January 9, 2006. (Group I) Claims 1-9 were provisionally elected rendering (Group II) Claims 11-15 to a non-elected invention.

RESPONSE TO REQUEST FOR RECONSIDERATION

2. Applicant's election with traverse of method of making a panel (Group II) is acknowledged. The traversal is on the ground(s) that "the alternative process is not materially different from the claimed process" because the claims are broad enough to encompass the use of extruded wood based materials. Because Applicant does not disclose extruding the material, therefore, the suggested alternative process is materially different from the claimed process. The traversal is also on the ground(s) that there is no serious burden on the Examiner in examining all of the claims together. The search of the 2 classes and subclasses would entail the requisite serious burden as the search for method of making is not the same as the article search. Additionally, the steps used in the method claims would not be expected to appear in the class/subclass of the product claims. Every panel is not made using the same method steps. The requirement is deemed proper and is therefore made FINAL.

Suggestion

3. In claim 1, Examiner suggests amending the phrase "in particular floor panel" to -- in particular a floor panel --. Correction is requested.

Claim Rejections – 35 USC § 103(a)

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Luck et al. (U.S. 4,283,450) in view of Chen et al (U.S. 6,617,009).

Luck discloses a panel having a core and high density skins having a density of about 40-55 lbs/ft³ (column 1, lines 11-21) having a dense skin on at least one surface of the core layer (column 3, lines 35-45) where it would have been obvious to one of ordinary skill in the art for the density of the top skin to be capable of being lower than the density of the lower skin layer. The skin layers are comprised of resin binders and urea formaldehyde (column 9, lines 44-52). Luck does not explicitly disclose a termination layer or isocyanate.

Chen teaches a flooring fiberboard (panel) having a core layer (column 1, lines 7-10) where the flooring comprises isocyanate binders and urea resins (column 1, lines

44-48) where the resin used for impregnation is urea formaldehyde (column 8, lines 60-62). Chen further teaches one or more wear layers or protective coatings are placed upon the material (column 12, lines 20-25). Luck and Chen are both directed to multilayer panels. It would have been obvious to one of ordinary skill in the art to have employed the protective layers (termination layers) and isocyanate and urea formaldehyde resins, as taught in Chen, in the panel of Luck because the protective layers provides improved durability to the panel and the isocyanate material improves the mechanical strength and bonding of the panel layers. Neither reference explicitly shows that the panel has a density, gluing factor or density distribution as claimed. However, such features are properties which can be easily determined by one of ordinary skill in the art. With regard to the limitations of the density, gluing factor or density distribution, absent a showing of unexpected results, it is obvious to modify the conditions of a composition because they are merely the result of routine experimentation. The experimental modification of prior art in order to optimize operation conditions (e.g. density, gluing factor or density distribution) fails to render claims patentable in the absence of unexpected results. All of the aforementioned limitations are optimizable as they directly affect the durability of the panel. It would have been obvious to one of ordinary skill in the art to make the panel with the limitations of the density, gluing factor or density distribution since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 USPQ 215 (CCPA 1980).

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is 571-272-1522. The examiner can normally be reached on Monday through Friday 9:00 AM – 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


L. Ferguson
Patent Examiner
AU 1774


RENA DYE
SUPERVISORY PATENT EXAMINER

A.U. 1774 3/3/04